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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,358	10/15/2001	Stephen Lange Ranzini	3892-4002	6886
27123	7590	12/19/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			GREENE, DANIEL L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/981,358

Applicant(s)

RANZINI ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 10-29, 53, 54, 60, 61, 63, 65, 67, 69 and 72-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 30-52, 55-59, 62, 64, 66, 68, 70 and 71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

Claims 30-41, 43-52, 56, 71 are objected to because of the following informalities: The claims are dependent on withdrawn claims i.e. 1, 5, 10 and 16.

Appropriate correction is required.

Claims 66, 68 and 70 are objected to because of the following informalities: The claims are dependent on the withdrawn #10 claim. Appropriate correction is required.

As per claims 8 and 56-58:

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claim 8** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant introduced a new limitation that uses the term **sending-user-specified** that is not in the Specification.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim, the written description must clearly define the claim term and set forth the

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definition so as to put one reasonably skilled in the art on notice that the applicant intended to so define that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "sending-user-specified" in claim 8 is indefinite because the specification does not clearly define the term.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

**Claim 8** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term **sending-user-specified** does not appear to be described in the Specifications. The confusion is created because in the claim, the terms used for the participants are, first entity and first entity's clearing bank. It is not clear what participant the Applicant is referring to when he introduced the term, sending-user-specified. The question becomes, is the sending-user-specified the first entity or the first entities clearing bank. Both can specify security attributes.

The Examiner will treat the limitation to mean, the sending entity security attributes are specified and set for the vault.

**Claims 56-58** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independent claim discloses the transfer of electronic cash from one bank to another. Claim 56-58 discloses real-time access for official government research that is associated with econometric and law enforcement.

The Applicant has not provided the motivation and/or logic how claims 56-58 depend on claim 8.

Further, the Applicant argues that the rejection is effectively resolved by directing the Examiner's attention to p. 19, lines 17-23 of the disclosure of the present application. The section referred to contains the term "... might need to alter ..." which maintains the rejection under 35 U.S.C. 112, second paragraph, and renders the section as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*In re John Covell Collier*, 55CCPA-; 397 F.2d 1003; 158 USPQ 266, Claim-Indefiniteness- Combination- Structural Relationships Between Elements not Positively Recited- 35 U.S.C. 112, second Paragraph. The statement " might need to alter" is about intended uses, capabilities, and structures, which will result upon the performance of future acts, is not a positive structural limitation. The Specification does not positively recite structural relationships of the elements in its recitation of what may or may not occur. In this sense it fails to comply with section 112, second paragraph, in failing distinctly to claim what applicant presents as his actual invention.

The main fault is indefiniteness in the sense that things, which may be done, are not required to be done. For example, "might need to alter" is a statement of possibility and is not a positive statement of fact. This cannot be regarded as structural limitations and therefore not as positive limitations in the Specification. "Might need to be altered" cannot therefor be relied on to distinguish from the prior art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 8, 9, 30-52, 55, 59, 62, 64, 66, 68, and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 20010018739A1-Anderson et al. [Anderson '739], US 6,427,140-Ginter et al. [Ginter '140], and further in view of US 5,371,797-Bocinsky, Jr. [Bocinsky, Jr '797]**

As per claim 8:

Anderson '739 disclose:

a first entity transmitting to the first entity's clearing bank a cash request electronic mail message, said message requesting that an electronic representation of cash be sent to a specified second entity; Fig. 3, 0174-0175

the first entity's clearing bank transmitting as an electronic mail message attachment to the second entity's clearing bank, Fig, 3, 0176-0177.

Anderson '739 discloses the claimed invention except for a digital rights management vault containing said electronic representation of cash. Ginter '140 teaches that it is known to utilize the concept of placing data into a VIDE content container/digital rights management container and associating control information with said data. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a VIDE content container/digital rights management

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container as taught by Ginter '140, since Ginter '140 states at Col. 22, lines 15-25 that such a modification would eliminate the constraints of having to use a few high level individual, pre-defined content provider increments.

Anderson '739 and Ginter '140 disclose the claimed invention except for wherein one or more of the sending users specified security attributes are set for the vault. Bocinsky, Jr teaches that it is known in the art to provide wherein one or more of the sending users specified security attributes are set for the vault. For example Fig. 2, elements 30 and 36, Abstract, Col. 11, lines 3-34, Col. 12, lines 4-34. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the elements of the documents of Anderson '739 with the sending users specified security attributes are set for the vault of Bocinsky, Jr ', in order to utilize the security keys of the sender.

As per claim 9:

Anderson '739 further disclose:

the second entity's clearing bank sending an electronic mail message to the first entity's clearing bank requesting receipt of the actual funds corresponding to said electronic representation of cash. [0226]

As per claim 30:

Anderson '739 and Ginter '140 further disclose:

wherein said digital rights management container relies on a security system which is based on an open standard cryptographic method by Anderson '739 [0073-0075] and Ginter '140 Fig. 10 Col. 8, lines 1-10 and Col. 67, lines 1-50,

Anderson '739 and Ginter '140 discloses the claimed invention including, determining the identity of the requestor, the authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform authentication protocols such as determining the identity of the requestor, authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. Anderson '739 Fig. 17 A/B and Ginter '140 Fig. 10.

As per claim 31:

Anderson '739 and Ginter '140 further disclose:

employing a message set order protocol and dataset that are proprietary; and publishing the application protocol interfaces corresponding to said message set and set dataset as an open standard. Anderson '739 [00730075] and Ginter '140 Fig. 10, Col. 8, lines 1-10 and Col. 67, lines 1-50,

Anderson '739 and Ginter '140 discloses the claimed invention including, determining the identity of the requestor, the authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. It would have been



obvious to one having ordinary skill in the art at the time the invention was made to perform authentication protocols such as determining the identity of the requestor, authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. Anderson `739 Fig. 17 A/B and Ginter `140 Fig. 10.

As per claim 32:

Anderson `739 further discloses the claimed invention except for accessing the databases or synergistic services. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 33:

Anderson `739 further discloses the claimed invention except for accessing the database directory of user's profiles and attributes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 34:

Anderson `739 further discloses the claimed invention except for accessing the database of aliases of users. It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 35:

Anderson `739 further discloses the claimed invention except for accessing the database of pending transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 36:

Anderson `739 further discloses the claimed invention except for accessing the database for validation services. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 37:

Anderson `739 further discloses the claimed invention except for accessing the database of eCheck numbers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 39:

Anderson '739 further discloses the claimed invention except for accessing the database of user authorities. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson '739. Fig. 24, [0252].

As per claim 40:

Anderson '739 further discloses the claimed invention except for accessing the database of auditing services. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson '739. Fig. 24, [0252].

As per claim 41:

Anderson '739 further discloses the claimed invention except for accessing the database of ERP data. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson '739. Fig. 24, [0252].

As per claim 42:

Anderson '739 further disclose:

wherein said database of ERP data secures its data pervasively using digital rights management. 0175-0180

As per claim 43:

Anderson '739 discloses the claimed invention except for utilizing XML compilers to speed up transaction rates and data processing speeds for ERP enabled messages. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to utilize XML compilers to speed up transaction rates and data processing speeds for ERP enabled messages since it is known in the art that XML compilers speed up transaction rates and data processing speeds for ERP enabled messages.

As per claims 44-48:

Anderson '739 discloses the claimed invention except for the providing customer service in the forms of a help wizard, self-executing software diagnostic tool, and an ERP help wizard. Ginter '140 teaches that it is known to provide customer service. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide customer service as taught by Ginter '140, since Ginter '140 states at Col. 26, lines 35-67 that such a modification would support user interaction.

As per claim 49:

Anderson '739 discloses the claimed invention, as discussed above, for performing a settlement using a bank payment system. It would have been an obvious matter of design choice to modify the teachings of Anderson '739 and Ginter '140 to provide performing a settlement using a

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bank payment system regardless of the terms used to describe the same action/entity be it, a first entity or customer or user, etc, be it using an ATM POS system, interfacing with a currency exchange provider, a conventional bank, performed in an automated manner etc. Since the applicant has not disclosed that using different names to describe the same thing solves any stated problem a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Anderson '739 and Ginter '140 will perform the invention as claimed by the applicant with any method, means, or product to perform a settlement using a bank payment system.

As per claim 50:

Anderson '739 further disclose:

performing settlement using an ATM POS system. [0222]

As per claim 51:

Anderson '739 further disclose

interfacing with a currency exchange service provider. [0224]

As per claim 52:

Anderson '739 further disclose

wherein said steps are performed in an automated manner. [0175-0177]

As per claim 55:

Anderson '739 further disclose

generating messages to transfer to a conventional bank the funds corresponding to said electronic representation of cash. [0226]

As per claim 59:

Anderson '739 further disclose

placing time-based limitations on the validity of said electronic representation of cash. [0242]

As per claim 62:

Anderson '739 further disclose

providing real-time transfer of the funds corresponding to said electronic representation of cash. [0226]

As per claim 64:

Anderson '739 further disclose

allowing a user requesting said transmission to select the authentication method to be used to access said descriptive data and said electronic representation of cash. [0226]

As per claim 66:

allowing said entities to establish subordinate users who may have similar or lesser authorities than a primary user.[0224]

As per claim 68:

further comprising the step of requiring a user requesting the transmission of said vault to select that a standard privacy matrix template be used to access said descriptive data and said digital representation of money. [0226]

As per claim 70:

Anderson '739 further disclose  
screening said electronic mail messages for viruses or other malicious code.  
[0174]

As per claim 71:

Anderson '739 further disclose  
protecting users from spam, denial of service attacks or other malicious interference. [0174]

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

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applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

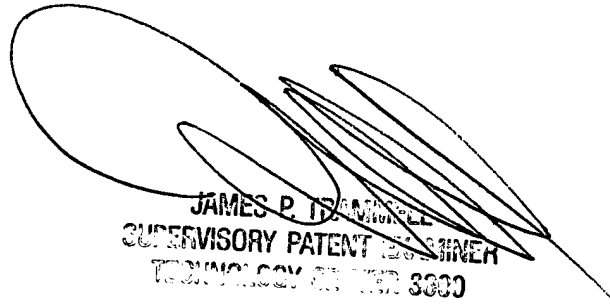
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JAMES P. THOMPSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600